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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,822	04/06/2001	Tomohisa Yamaguchi	0020-4845P	6454

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/826,822

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Raquel Alvarez

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-38 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 16-38 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is in response to communication filed on 2/10/2005.
2. Claims 1-15 have been canceled. Claims 16-38 are presented for examination.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 16-25, 28-34 and 37-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett et al. (6,336,099 hereinafter Barnett).

With respect to claims 16-19, 22-24, 28-29, 31-32, 33, 37, 38 Barnett teaches an information communication system including an information terminal and an information collecting device for exchanging information via communication means (Figure 1). The information terminal device comprising advertisement information saving means for saving advertisement information (i.e. the coupon data package and associated advertising materials are transmitted by the online service provider 2 to the personal computer 6, where it is stored in the downloaded coupon data file 30a in the coupon database 30); display means (display 24); advertisement presenting means for displaying the saved advertisement information on the display means (Figure 4A-4B);

Art Unit: 3622

advertisement using means for detecting a user operation by a user interface occurring upon display of an advertisement; advertisement use information storing means for storing the advertisement use information (i.e. coupon request and user data 4 is stored); advertisement use information sending means which is connected to the communication means and sends the stored advertisement use information to the information collecting device via the communication means (i.e. user data is sent to the coupon distributor 16); the information collecting device receives the advertisement use information sent from the information terminal device via the communication channel (see Figure 1); advertisement use information collecting means for collecting the received advertisement use information (Figure 1); the advertisement information saving means, advertisement presenting means, advertisement using means and advertisement use information storing means in the terminal device can operate even in a state that the advertisement use information sending means is not connected to the communication channel (i.e. The offline coupon data management routines 32 are executed by the processor 26 in conjunction with the coupon database 30 in order to request, obtain, store, select, sort, and print coupons as desired. The offline coupon data management routines 32 are executed by selecting a desired function button 52, 54, 56, or 58 as shown in the offline display screen 50 in FIG. 4b. The offline display screen 50 is shown on the display 24 when the user runs the coupon data management program on his or her personal computer 6. The offline coupon data management routines 32 are executed in an offline fashion; that is, the user does not need to first be in online communication with the service provider 2).

Art Unit: 3622

With respect to claims 20-21, 30, Barnett further teaches analyzing means for determining advertisement information to be sent to the information terminal device based on an analytical result (i.e. based on the information analyzed, subsequent advertisements are coupons are distributed)(col. 6, lines 62-65).

With respect to claims 25, 34, Barnett further teaches the advertisement presenting means displays an advertisement by utilizing part of a screen display on the display means for prompting a user for confirmation (i.e. the user is presented with the ads and the user selects the ads in order to confirm the order of the coupons)(col. 8, lines 23-33); a service instructed by the advertisement using means is changing contents of the display advertisement (i.e. the advertisements are changed based on the information received)col. 6, lines 62-65).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26-27 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett.

Art Unit: 3622

Claims 26, 35 further recite presenting the advertisements when the power is turned off and suspending the turning off the power to instruct the service. Presenting information even when the power is turned off and suspending off the power to instruct for service well make sense in order to not discontinue the presentation of the information and to not further damage the system and delay the turning on of the power until service is rendered. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included presenting the advertisements when the power is turned off and suspending the turning off the power to instruct the service in order to achieve the above mentioned advantage.

Claims 27, 36 further recite a warning screen displayed on the display means when an application program is waiting for an operation and a service instructed by the advertisement using means is changing contents of the operation started after the operation wait state finishes. Official notice is taken that is old and well known to suspend an operation when a warning is displayed in order to avoid system's problems. It would have been obvious for a person of ordinary skill in the art at the time of Applicant's invention to have included a warning screen displayed on the display means when an application program is waiting for an operation and a service instructed by the advertisement using means is changing contents of the operation started after the operation wait state finishes in order to achieve the above mentioned advantage.

**Response to Arguments**

5. The amendment to the claims overcame the 112, 2<sup>nd</sup> rejection.
6. Translation of Japanese patents JP 11-338809 and JP 9-163352 was received, therefore the 105 requirement has been withdrawn.
7. Applicant argues that Barnett doesn't teach use information sending means. The examiner respectfully disagree with Applicant because Barnett teaches the coupons (ads) requested by the users are stored and transmitted to coupon distributor 16 (see Figure 1).
8. With regard to the examiner's use of Official Notice, since, Applicant didn't provide a proper challenge that would at least cast reasonable doubt on the fact taken notice of, the Official notice is sustained. See MPEP 2144.03 where In re Boon is mentioned.

**Conclusion**

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3622

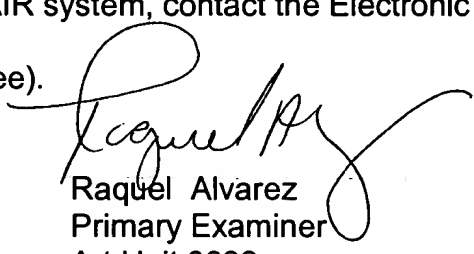
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Point of contact**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raquel Alvarez  
Primary Examiner  
Art Unit 3622

R.A.  
5/12/05